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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Newman.

Serial No.: 09/839,444

Confirmation No.: 4848

Filed: April 23, 2001

For: METHOD OF MANAGING A WELL FILE
RECORD AT A WELL SITE

Group Art Unit: 2862

Examiner: T. Le

Atty. Dkt. No.: 13526.0023.NPUS00

Handwritten: H/O Response OK 7/15/03

RESPONSE TO OFFICE ACTION MAILED JUNE 2, 2003

Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF EXPRESS MAIL	
NUMBER	EV318621961US
DATE OF DEPOSIT	<u>7-8-03</u>
I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA, 22313-1450.	
 Signature	

INTRODUCTORY COMMENTS:

The following is submitted in response to the Office Action dated June 2, 2003:

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erial No.: 09/839,444
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Applicant: Newman
Atty. Ref.: 13526.0023.NPUS00

AMENDMENTS TO THE CLAIMS:

No amendments are being made to the claims at this time.

IN RESPONSE TO THE OFFICE ACTION:

COMMENTS:

On February 18, 2003, the currently pending claims were rejected under both 35 U.S.C. § 102 and 35 U.S.C. § 103 as allegedly being anticipated by or obvious in view of U.S. Patent 6,377,189, issued to Frederic M. Newman, the same Frederic M. Newman who is the inventor of material disclosed and claimed in the instant application.

On March 6, 2003, Applicant's representative discussed the instant application with the Examiner. During that discussion, Applicant's representative pointed out to the Examiner that the cited reference, U.S. Patent No. 6,377,189 did not qualify as a prior art reference to this application. In particular, the '189 patent's issue date was April 23, 2002. Because the instant application was filed April 23, 2001, the '189 patent did not qualify as prior art under either § 102(a) or § 102(b). Although the '189 patent was filed on March 31, 1999, before the instant application's filing date, the '189 reference did not qualify as § 102(e) prior art because the '189 reference's Applicant is the same Applicant in the instant application, and therefore did not meet the "by another" requirement of § 102(e).

The Examiner agreed with the Applicant's representative's statements, and agreed to withdraw the final rejection issue a new, non-final rejection. Applicant's representative then submitted a "Request to Withdraw Final Office Action" outlining the content of the conversation between the Examiner and the Applicant's representative.

Applicant's request was granted by the Examiner, and a new, non final Office Action was mailed on June 2, 2003. All of the pending claims were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over "Newman"—no patent number was listed. Applicant's representative spoke with the Examiner on July 7, 2003, so as to ascertain what Newman patent was the basis of the rejection. The Examiner informed the Applicant's representative that, again, it was U.S. Patent No. 6,377,189. When Applicant's representative told the Examiner that this reference was not available to him to reject the claims, the Examiner stated that this was not a § 102 rejection, but instead was a § 103 rejection and the '189 patent was therefore available to reject the claims.

The MPEP clearly states that subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section § 103. MPEP § 2141.01(I). The entirety of MPEP § 2141.01(I) is reproduced below for the Examiner's assistance:

I. PRIOR ART AVAILABLE UNDER 35 U.S.C. § 102 IS AVAILABLE
UNDER 35 U.S.C. § 103

"Before answering Graham's 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section § 103. *Ex parte Andresen*, 212 U.S.P.Q. 100, § 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section § 103 as including all of the various bars to a patent as set forth in section § 102.").

A 35 U.S.C. § 103 rejection is based on 35 U.S.C. § 102(a), § 102(b), § 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. § 102(b). Analogously, an obviousness rejection based on a publication which would be applied under § 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

For an overview of what constitutes prior art under 35 U.S.C. § 102, see MPEP § 901 - § 901.06(d) and § 2121 - § 2129.

MPEP § 2141.01(I).

As is clear from this section of the MPEP, art that would qualify under § 102 is available to reject claims under § 103. The second paragraph is particularly applicable to the instant situation. First sentence of MPEP § 2141.01(I). : "A 35 U.S.C. § 103 rejection is based on 35 U.S.C. § 102(a), § 102(b), § 102(e), etc. depending on the type of prior art reference used and its publication or issue date." In this case, the 35 U.S.C. § 103 rejection is based on § 102(e). As explained above, the only thing U.S. Patent No. 6,377,189 could be is a § 102(e) reference. The issue date of the '189 patent is April 23, 2002, so because the instant application was filed April

23, 2001, the '189 patent does not qualify as prior art under either § 102(a) or § 102(b) (i.e. was not published "before" the invention of the instant application). The '189 patent was filed on March 31, 1999, which was before the instant application's filing date, making § 102(e) the only option to qualify the '189 patent as a prior art reference to the instant application.

The third sentence of MPEP § 2141.01(I) reads as follows: "Analogously, an obviousness rejection based on a publication which would be applied under § 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131." What this is saying is that if an obviousness rejection is based on a § 102(a) publication, it can be overcome by swearing behind the § 102(a) reference. Therefore, like with an anticipation rejection, if an Applicant can remove the § 102(a) reference by swearing behind it, it is not available for use in a § 103 rejection.

The same can therefore be said for art that falls under § 102(e). An obviousness rejection based on a publication which would be applied under § 102(e) if it anticipated the claims can be overcome by showing that the reference is not prior art under § 102(e). As was shown previously to the Examiner, the '189 reference does not qualify as § 102(e) prior art because the '189 reference's Applicant, Frederic M. Newman, is the same Frederic M. Newman who is the applicant in the instant application. Therefore, the '189 patent is not "by another" as required by § 102(e), and is not appropriate § 102(e) prior art. Because it is not proper § 102(e) prior art, it cannot be used to make a rejection under § 103.

This is supported the P.J. Frederico's commentary accompanying the Patent Act of 1952 which is instructive on the issue of what type of prior art is available for use under § 103:

In form this section [35 U.S.C. § 103] is a limitation on section § 102 and it should more logically have been made part of section § 102, but it was made a separate section to prevent § 102 from becoming too long and involved and because of its importance. The antecedent of the words 'the prior art,' which here appear in a statute for the first time, lies in the phrase 'disclosed or described as set forth in section § 102' and *hence these words refer to material specified in section § 102 as the basis for comparison.*

The general part of the Committee Report states with reference to section § 103:

Section § 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writing. Section § 103 states this requirement in the title. *It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section § 102.* If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

P.J. Frederico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 20 (1954), *reprinted in* 75 J. Pat. Off. Soc'y 161 (1993). Clearly, the impetus of this commentary is that § 102 art can be used to support § 103 rejections. A corollary, of course, is that if a printed reference is NOT § 102 art, it cannot be used to support a § 103 rejection. As is clearly stated above, for the purposes of this application, the '189 reference is NOT proper § 102(e) art, and therefore cannot be the basis for either a § 102 rejection or a § 103 rejection.

Clearly, a reference must qualify as prior art under § 102 before it can be used to make an obviousness rejection. The '189 patent is not § 102(e) prior art in this case because the inventive entity for both the '189 patent and the instant application, Frederic M. Newman, are exactly the same. Thus, the Examiner has not made a *prima facie* showing of obviousness because the purported rejection is based on a reference that the Examiner cannot use to make rejections to the currently pending claims. Therefore, the Examiner's § 103 obviousness rejections to all the claims should be withdrawn, and the claims allowed.

While no fees are believed to be due at this time, the undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 13526.0023.NPUS00.



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In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. F. Steinheider', written over a horizontal line.

Matthew F. Steinheider

Patent Attorney

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Date: 7/8/03